

REMARKS

Applicant is in receipt of the Office Action mailed February 27, 2004. Claims 1-54 remain pending in the case. Further consideration of the present case is earnestly requested in light of the following remarks.

Section 103 Rejections

Claims 1-8, 10-18, 20-23, 29-38, and 40-54 were rejected as being unpatentable over Conrad et al. (US 6,061,061, "Conrad") in view of Mangat et al. (US 6,081,814, "Mangat"). Applicant respectfully traverses the rejection.

As the Examiner is certainly aware, to establish a prima facie obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. In re Bond, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

As held by the U.S. Court of Appeals for the Federal Circuit in Ecolochem Inc. v. Southern California Edison Co., an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination.

Applicant respectfully submits that neither Conrad nor Mangat provides a motivation to combine, and so the references are not properly combinable for a 103

rejection. Additionally, Applicant submits that even if Conrad and Mangat were properly combinable, which Applicant argues they are not, the resulting combination would not produce Applicant's invention as claimed.

Claim 1 recites:

1. A computer-implemented method for adding program elements to programs in a graphical user interface displayed on a computer system, wherein the computer system includes a display, the method comprising:

displaying one or more windows of a program currently being edited on the display;

displaying a search window on the display;

receiving user input in the search window specifying a search criteria;

identifying and displaying information regarding a plurality of possible program elements in the search window in accordance with the search criteria user input;

receiving user input selecting a program element from the plurality of possible program elements; and

incorporating the selected program element in a first window of the one or more windows of the program.

Applicant submits that neither Conrad nor Mangat discloses *adding program elements to programs in a graphical user interface displayed on a computer system*.

The Office Action asserts that Conrad discloses displaying one or more windows of a program currently being edited on the display, citing figure 2E, windows 23, 24, 25. Applicant respectfully disagrees. The cited figure illustrates windows representing file folders or directories, and moving or copying (via dragging of an icon) a file from a source window (folder or directory) to a destination window (folder or directory). Applicant notes that icon dragging operations are well known in the art of graphical user interfaces, especially in graphical operating systems such as MacOS and Windows. Applicant submits that, as described in the Abstract, Conrad discloses "a new behavior in a graphical user interface" that "allows the user to open and close enclosures, while dragging an object". Nowhere does Conrad teach, suggest, illustrate, or even mention

editing, displaying, or creating a program, nor does Conrad teach, suggest, mention, or even hint at a search capability. In fact, Conrad fails to teach or suggest *any* of the limitations of claim 1. Thus, Applicant respectfully submits that Conrad's system is not relevant to Applicant's system as represented in claim 1, and in fact, teaches away from Applicant's invention as claimed. Applicant thus submits that combining Conrad with Mangat for a 103 rejection is improper.

The Office Action attempts to combine Mangat with Conrad in an effort to overcome the deficiencies of Conrad. However, Applicant submits that Mangat does not teach or suggest most of the limitations of claim 1. For example, although Mangat does disclose a search window and a search engine, nowhere does Mangat teach or suggest *displaying one or more windows of a program currently being edited on the display*. In fact, Mangat does not mention creating or editing a program at all. Furthermore, Mangat neither teaches nor suggests *identifying and displaying information regarding a plurality of possible program elements in the search window in accordance with the search criteria user input*, nor *receiving user input selecting a program element from the plurality of possible program elements*, nor *incorporating the selected program element in a first window of the one or more windows of the program*.

Thus, for at least the reasons presented above, Applicant submits that neither Conrad nor Mangat, either singly or in combination, teaches Applicant's invention as represented in claim 1. Thus, claim 1 is patentably distinct and unobvious over Conrad in view of Mangat. Thus, Applicant respectfully submits that claim 1 and those claims dependent thereon are allowable.

Independent claims 11, 20, 32, 40, 44, 49, 52, and 54 include similar limitations as claim 1, and so the arguments above apply with equal force to these claims. Thus, Applicant submits that claims 11, 20, 32, 40, 44, 49, 52, and 54, and those claims respectively dependent thereon, are patentably distinct and unobvious over Conrad in view of Mangat, and are thus allowable.

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the independent claims have been shown to be patentably distinct, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

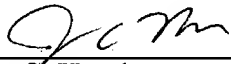
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-43101/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Request for Approval of Drawing Changes
- ☒ Notice of Change of Address
- ☐ Check in the amount of \$ for fees ().
- ☐ Other:

Respectfully submitted,



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